

AMENDMENT AFTER FINAL  
May 19, 2005

JP919980804US1  
Serial No. 09/681,788

### REMARKS

Claims 1 – 3 and 6 – 18 remain in the application and stand finally rejected. Claim 5 is objected to. Claims 1, 9 – 13, 15, and 17 are amended in the purposed amendment offer herein. Claims 4 and 5 are canceled in the proposed amendment.

Claim 5 is objected to. Although the reason for the objection is not specified, the office action indicates that the applicants' arguments with respect to claim 5 were persuasive. Therefore, it is assumed that claim 5 is objected to for depending from a rejected base claim but, would be allowable if rewritten to include the recitations of the independent claim and any intervening claims from which claim 5 depends. In the proposed amendment, claims 1 and 11 are amended to include the recitations of claims 4 and 5. So, proposed amended claim 1 is claim 5 written in independent form. Therefore, it is believed that proposed amended claims 1 and 11 are allowable. Reconsideration and withdrawal of the objection to claim 5 is respectfully solicited. Further, reconsideration and withdrawal of the rejection of claims 1 and 11 is respectfully solicited.

Claims 2, 3 and 6 – 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Blakeslee in view of U.S. Patent No. 5,959,260 to Hoghooghi et al. However, for the reasons that proposed amended claim 1 is allowable, claims 2, 3 and 6-8, which depend from claim 1, include all the differences with the cited references as amended claim 1 from which they depend. Accordingly, dependent claims 2, 3 and 6 – 8, also are believed to be allowable by this amendment. Reconsideration and withdrawal of the rejection of claims 1 – 3, 6 – 8 and 11 under 35 U.S.C. §103(a) as being unpatentable over Blakeslee in view Hoghooghi et al. of is respectfully solicited.

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Claims 9, 10 and 12 are finally rejected under 35 U.S.C. §102(b) over GB 2,308,523 A to Blakeslee. In the final rejection, it is asserted, essentially, that Blakeslee teaches the present invention as claimed. In particular it is asserted that "Blakeslee discloses selecting an area on a writing area (screen 12) of an input device (pocket-sized mobile telephone device 10) as a dialing area (display 12A); loading a program for defining the dialing area...." In responding to arguments to the previous amendment, it is asserted the argued differences that were not recited in the claims, i.e., that "selected area is a portion of the writing area"; 'dialing area may be the size of a sheet of paper'; 'dialing area is defined as a region of (or adjacent to) a page being faxed) (sic) are not recited in the rejected claim(s)."

Applicants note that claims 14 and 18 recite that, the "dialing area is defined as a region adjacent a fax page display area of said writing area" and claims 13 and 17 clearly recite that, the "dialing area is defined as a region of said page being faxed" at lines 2 – 3. Given that the dialing area is an "area on a writing area of an input device" (claim 9, line3) these recitations clearly indicate that: the area selected as the dialing area is a portion of the writing area; and that the dialing area is a region of (or adjacent to) a page being faxed. *See also*, claims 15 and 16. Further, claims 13, 14, 17 and 18 clearly recite that, the "writing area has a form factor coinciding with that of a standard paper size" and so, may be the size of a sheet of paper. As has been previously noted, Blakeslee fails to teach any of this.

As previously noted, Blakeslee teaches a cell phone capable of inputting, transferring and receiving digital ink messages. *See, e.g.*, Abstract. The cell phone includes, "a touch-sensitive display screen 12, having an area of approximately 5cm x 4cm" Blakeslee page 1, lines 17 – 19. Blakeslee Figure 3 shows portions of a fax page 21 being displayed on display 12. Page 12, line 33 – page 13, line 8, page 15, lines 5 – 8 and page 16 lines 9 – 13. The Blakeslee cell phone has a 5cm x 4cm display screen 12 that has a form factor other than a standard paper size. Page 1, lines 18 – 19. Applicants

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note that the Blakeslee screen contents would be unintelligible when displaying the contents a standard size sheet of paper being faxed. Blakeslee Figure 2 shows that the cell phone display 12 displays mutually exclusively displays each of a number of different panels, selection of which depend upon the particular function provided by the screen. So, for example the Blakeslee screen 12 can display a call function panel for an outgoing call screen 12A, an incoming call 12B or a telephone dialing keypad 12C. Page 12, lines 14 – 27. In each instance, regardless of the selected function, the corresponding function panel occupies the entire Blakeslee display.

Regarding the rejection of claims 9, 10 and 12, Blakeslee does not teach that the dialing area is "defined such that a portion of a page being faxed is simultaneously displayed with said dialing area" as recited in proposed amended claim 9, lines 5 – 6; claim 10, lines 8 – 10; and claim 12, lines 4 – 5. To the contrary, Blakeslee shows that one can only display, mutually exclusively, either the dialing panel 12C or fax content (e.g., 12D), but not both simultaneously. Accordingly, Blakeslee does not teach the present invention as recited in proposed amended claims 9, 10 and 12 or claims 13 – 18 as previously presented. Applicants respectfully request that the examiner enter the amendment and reconsider and withdraw of the final rejection of claims 9 – 18 under 35 U.S.C. §102(b) over Blakeslee.

The applicants thank the Examiner for efforts both past and present in examining the application. Believing the proposed amendment to place Application in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicants request that the Examiner enter the amendment, reconsider and withdraw the objection to claim 5, reconsider and withdraw the rejection to claims 1 – 3 and 6 – 18 under 35 U.S.C. §§102(b), 103(a) and allow the Application to issue.

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Should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

Please charge any deficiencies in fees and credit any overpayment of fees to IBM Corporation Deposit Account No. 50-0510 and advise us accordingly.

Respectfully Submitted,



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